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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1785.1014

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on 05/06/2008

Signature

Typed or printed name

Aaron C. Walker

Application Number

10/810,698

Filed

03/29/2004

First Named Inventor

Kuniyasu Matsumoto

Art Unit

3682

Examiner

James Pilkington

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 59,921

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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05/06/2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

☐

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No.: 1785.1014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kuniyasu MATSUMOTO et al.

Serial No. 10/810,698

Group Art Unit: 3682

Confirmation No. 1172

Filed: March 29, 2004

Examiner: James Pilkington

For: LAYING DEVICE FOR LAYING LINE ELEMENT

PRE-APPEAL BRIEF CONFERENCE REQUEST

Mail Stop AF

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

A Petition for a Third Month Extension of Time, together with the requisite fee, is enclosed thereby extending the response due date to May 6, 2008. If there are any additional fees associated with filing of this Request, please charge the same to our Deposit Account No. 19-3935.

REMARKS

Claims 1-8 are pending. Claims 5-6 and 8 have been withdrawn as directed to a non-elected species. The independent claim is claim 1.

Claims 1-4 and 7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Fiora (U.S. Patent No. 6,014,909) in view of AAPA (Applicants' admitted prior art).

An After Final Amendment was filed on February 26, 2008 presenting arguments that Fiora and AAPA do not meet the limitations of independent claim 1. In the February 26, 2008 After Final Amendment, independent claim 1 was not amended. The Advisory Action of April 1, 2008 checked box 11, stating that request for reconsideration has been considered but does not place the application in condition for allowance.

A pre-appeal brief panel review of the identified appealable issues I and II is requested.

I. The rejections under 35 U.S.C. § 103 are vague and incomplete ignoring positively recited features of the claims

In the final Office Action dated November 6, 2007, claims 1-4 were rejected under 35 USC § 103(a) as being unpatentable over Fiora in view of AAPA.

The combination of Fiora and AAPA does not discuss or suggest:

wherein said laying device comprises a straight relay connector for relaying an arm side section of the line element, extending through said hollow portion out of a lead-out opening formed on a side of said rotation shaft member, to a tool side section of the line element extending from the tool, so that a direction in which said straight relay connector connects the line element is substantially parallel to said tool mount surface and forms an angle other than 0° with regard to a radial direction perpendicular to the rotation axis,

as recited in claim 1. In other words, the invention of claim 1 provides for a straight relay connector for relaying the arm side section of the line element to the tool side section of the line element, wherein the direction of connection is both substantially parallel to the tool mount surface and forms an angle other than zero degrees with a radial direction perpendicular to the rotation axis. Thus, the invention of claim 1 provides an interference area that is smaller than the conventional relaying portion. The Examiner, at pages 3 and 6 of the Office Action dated November 6, 2007, indicates that straight relay connectors could be substituted for the elbow connectors 57 of Fiora in order to achieve the invention of claim 1. However, this is submitted to be incorrect. Referring to Fig. 4 of Fiora, if the elbow connectors 57 of Fiora were replaced with

straight relay connectors, then the prior art configuration illustrated in Fig. 5 of the present application would result. Such a configuration does not provide for a direction of connection that forms an angle other than zero degrees with a radial direction perpendicular to the rotation axis. As such, this suggested combination would result in a larger interference area, which is contrary to the invention of claim 1.

Furthermore, the Examiner's explanation of the cited Fiora reference is extremely vague. Applicants are unclear as to what the Examiner means when he suggests, at page 6 of the Office Action dated November 6, 2007, that the elbow connectors of Fiora could be replaced with straight relay connectors in the same direction as the relay portion located near character 58. The stated "in the same direction as the relay portion located near character 58" is overly vague. In any manner, such a suggested configuration does not seem functional and, even if such a configuration were possible, it is submitted that such a configuration would not provide a direction of connection that is substantially parallel to the tool mount surface 20 of Fiora. Therefore, the Examiner's suggested combination of Fiora and AAPA does not provide that a direction in which the relay connector connects the line element is substantially parallel to the tool mount surface and forms an angle other than 0° with regard to a radial direction perpendicular to the rotation axis, as claimed in claim 1.

II. The Examiner's proposed modification of the prior art renders the prior art unsatisfactory for its intended purpose and changes the principle operation of the prior art

In the Advisory Action dated April 1, 2008, the Examiner states that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. However, the MPEP does require state that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and MPEP 2143.01. Fiora, at col. 4, lines 34-38, discloses that connectors 57 are arranged radially "for connecting the various utilities on the tool secured to the coupling flange 24." As such, if the elbow connectors 57 were to be replaced with straight connectors, as suggested by the Examiner, the apparatus of Fiora would not function as intended because the various utilities could not be connected to a tool secured to the coupling flange 24 without a substantial redesign.

Furthermore, the MPEP also states that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then

the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) and MPEP 2143.01. Again, if the elbow connectors 57 of Fiora were to be replaced with straight connectors, as suggested by the Examiner, the apparatus of Fiora would not be capable of connecting the various utilities to a tool secured to the coupling flange 24.

Since the combination of Fiora and AAPA does not teach or make obvious all of the features of claim 1, claim 1 patentably distinguishes over Fiora and AAPA. Accordingly, withdrawal of this § 103(a) rejection is respectfully requested.

Claims 2-4 depend either directly or indirectly from claim 1 and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 2-4 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

In the Office Action dated November 6, 2007, claim 7 was rejected under 35 USC § 103(a) as being unpatentable over Fiora and AAPA and further in view of Szydel (U.S. Patent No. 5,777,267).

As discussed above, the combination of Fiora and AAPA does not teach or make obvious all of the features of claim 1. Szydel fails to make up for this deficiency, so that claim 1 patentably distinguishes over Fiora, AAPA, and Szydel. Claim 7 depends directly from claim 1 and includes all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claim 7 patentably distinguishes over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

In the Office Action dated November 6, 2007, claims 1-4 were rejected under 35 USC § 103(a) as being unpatentable over Fiora in view of Saba (U.S. Patent No. 5,454,737).

Saba has been cited by the Examiner merely as an example of a straight relay connector. The Examiner indicates that straight relay connectors of Saba could be substituted for the elbow connectors 57 of Fiora in order to achieve the invention of claim 1. However, this is submitted to be incorrect for the same reasons as discussed above with respect to AAPA. Therefore, the Examiner's suggested combination of Fiora and Saba does not provide that a direction in which said relay connector connects the line element is substantially parallel to said tool mount surface and forms an angle other than 0° with regard to a radial direction

perpendicular to the rotation axis, as claimed in claim 1. Accordingly, withdrawal of this § 103(a) rejection is respectfully requested.

Claims 2-4 depend either directly or indirectly from claim 1 and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 2-4 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

In the Office Action dated November 6, 2007, claim 7 was rejected under 35 USC § 103(a) as being unpatentable over Fiora and Saba and further in view of Szydel.

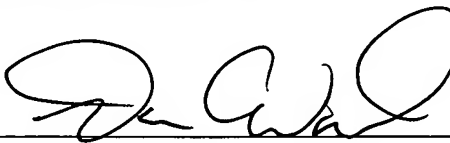
As discussed above, the combination of Fiora and Saba does not teach or make obvious all of the features of claim 1. Szydel fails to make up for this deficiency, so that claim 1 patentably distinguishes over Fiora, Saba, and Szydel. Claim 7 depends directly from claim 1 and includes all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claim 7 patentably distinguishes over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 5-6 and 8 have been withdrawn as directed toward a non-elected species. Claims 5-6 and 8 each depend directly from claim 1. As discussed above, claim 1 patentably distinguishes over the cited prior art and is now in a condition suitable for allowance. Since claim 1 is a generic claim, as acknowledged by the Examiner in the Office Action dated March 27, 2007, Applicants respectfully request consideration of claims 5-6 and 8.

Respectfully submitted,

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Date: 5-6-08

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